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**OFFICE OF PETITIONS**

In re Patent No. 6,505,391 :  
Philippe Berna :  
Issue Date: January 14, 2003 : DECISION ON  
Application No. 08/580,493 : REQUEST FOR RECONSIDERATION  
Filed: December 29, 1995 :  
Title: PROCESS FOR MAKING A :  
VERSATILE CLAMPING DEVICE :  
DESIGNED TO HOLD OBJECTS :  
WITHOUT DAMAGING THEM, SUCH A :  
DEVICE AND ITS USE :

This is in response to the REQUEST FOR RECONSIDERATION TO THE DECISION OF JULY 19, 2007 ON THE RESPONSE TO THE DECISION ON THE PETITION FILED ON JULY 11, 2003 filed September 4, 2007 (and resubmitted September 19, 2007). This is patentee's second request for reconsideration (and third petition).

On July 14, 2003, patentee filed his first petition, asserting that the instant patent should not be subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2). By decision mailed December 20, 2005, the petition was dismissed. On March 10, 2006, patentee filed his first request for reconsideration. By decision mailed July 19, 2007, the request for reconsideration was dismissed. In response, this second request for reconsideration was timely filed.

This request for reconsideration is granted to the extent that the decision on petition mailed July 19, 2007 has been reconsidered; however, this request is DISMISSED with respect to making any change in the decision affirming the conclusion that the patent is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2) and that subject to any disclaimer, the twenty year term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 19 days for examination delay.

Patentee's arguments have been considered, but not found persuasive. Patentee's arguments are predicated on 2 conclusions: 1) that the Office acted contrary to law or without authority or otherwise erred in treating the paper filed August

23, 2001 under former rule 62 as a continued prosecution application (CPA), and more importantly, 2) that this application was filed before June 8, 1995 and thus, is subject to a patent term of greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

Patentee erred in filing a continuation application under former rule 62 on August 23, 2001. 37 CFR 1.62 was deleted effective December 1, 1997. See 1203 O.G. 63, October 21, 1997. The Office properly treated the filing as a continued prosecution application (CPA), rather than as an improper application. For the benefit of applicants who continued to use former rule 62, up until the time that CPA practice was discontinued in July of 2003, a continuation or divisional application filed under former rule 62 was treated as a continued prosecution application (CPA). CPA practice under 37 CFR 1.53(d) replaced file wrapper continuation practice under from rule 62. The practice of treating papers filed under former rule 62 as CPAs is well established and was long stated in the Manual of Patent Examination Procedure (MPEP) at the time of the filing. This practice is within the authority of the Director to proscribe rules of practice not inconsistent with law.

Moreover, at the time of the filing of the paper on August 23, 2001, the provisions regarding filing a request for continued examination (RCE) and the provisions regarding patent term adjustment under 35 U.S.C. 154(b) were in effect. Specifically, it was stated in the Final Rule and in the MPEP that, the filing of a CPA under 1.53(d) on or after May 29, 2000, would render an application subject to the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by 4402 of the American Inventors Protection Act of 1999. Thus, the information was available to then applicant to make a determination as to whether the filing of an RCE rather than paper under former rule 62 would be more appropriate given the patent term adjustment provisions.

Nonetheless, what has not been made clear to patentee is that the URAA provisions he cites are not applicable to this application irrespective of the filing of the CPA. For applications filed on or after June 8, 1995, Section 532(a)(1) of the Uruguay Round Agreements Act (Pub. L. 103-465, 108 Stat. 4809 (1994)) amended 35 U.S.C. 154 to provide that the term of a patent (other than a design patent) begins on the date the patent issues and ends on the date that is twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), twenty years from the filing date of the earliest of such application(s). **However, this application was not filed on or before June 8, 1995.** If the date of filing of the CPA were not used in determining the patent term of this application, the actual filing date of the application would be. **The filing date of this application is December 29, 2005.** This is after June 8, 1995, and thus, the provisions of the URAA cited do not apply. The dates of filing of the prior applications to which this application claims priority are not used in determining the applicable provision on patent term. In other words, the application does not become subject to the patent term provisions for applications filed on or before June 8, 1995 pursuant to the URAA because it claims priority to applications filed on or

before June 8, 1995. Rather, because this application was filed on December 29, 1995, regardless of the filing of the CPA on August 23, 2001, the application would be subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2).

What the filing of the CPA on August 23, 2001 does is make the application entitled to the patent term adjustment provisions for examination delay. 37 CFR §1.701 applies to original (non-reissue) patents issued on applications (other than for a design patent) filed on or after June 8, 1995, and before May 29, 2000. Section 701 does not provide for patent term adjustment for "examination delay." Sections 1.702 through 1.705 apply to original applications (other than for a design patent) filed on or after May 29, 2000, and to patents issued on such applications. These sections provide for patent term adjustment for examination delay. Pursuant to these later sections, the patent issued with the twenty-year term and a revised patent term adjustment of 19 days for examination delay.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are not permitted. See 1.181(f).

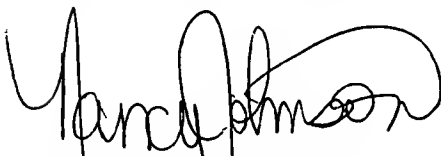
Further correspondence with respect to this decision should be addressed as follows:

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Telephone inquiries with regard to this communication should be directed to the undersigned at (571) 272-3219.



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